

REMARKS

I. IN THE OFFICE ACTION

The Examiner provisionally rejected claims 1-20 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-23 of copending Application No. 09/877,341. Office Action, page 2. The Examiner states that “[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the process for forming a drag reducing agent and the drag reducing agent slurry so produced may be the same, i.e., a mixture of an ultra high molecular weight polyalphaolefin and an alcohol.” *Id.* The Examiner notes that the rejection is a “provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.” *Id.*

The Examiner then rejected claims 1-3, 6, 7, 12-15, and 20 under the provisions of 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,733,953 issued to Fairchild (“Fairchild”). The Examiner states that Fairchild disclosed adding a “liquid, non-solvent, such as an alcohol, to a drag reducing polymer, such as a polyalphaolefin, at a rate slow enough to permit the polymer mixture to absorb the liquid non-solvent. Office Action, page 3. The Examiner states that Fairchild discloses alcohols containing 2 to 6 carbon atoms which include 1-pentanol and 1-hexanol. *Id.* The Examiner then states that “[a]lthough an amount of alcohol absorbed such as ‘at least 0.5% greater than the polyalphaolefin weight’ is not set forth in Fairchild, the reference does teach that the polymer absorbs the liquid, non-solvent, which includes alcohols.” *Id.*

The Examiner did not reject, object to, or allow claims 4,5, 8-11, or 16-19.

II. DISCUSSION

A. Provisional Double Patenting Rejection

As noted by the Examiner in the Office Action, a timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) may be used to overcome an actual or provisional rejection based upon nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application as required by 37 C.F.R. § 1.130(b).

Submitted herewith is a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) together with a check in the amount of \$65.00 as required by 37 C.F.R. § 1.20(d). The present application and Application Serial No. 09/877,341 are commonly owned by Assignee Energy & Environmental International, L.C. as evidenced by the assignment recorded with the U.S. Patent and Trademark Office at Reel 011892, Frame 0142. Accordingly, the submitted Terminal Disclaimer is in compliance with 37 C.F.R. § 1.321(c) and 37 C.F.R. § 1.130(b). Therefore, Applicant respectfully requests that the provisional obviousness-type double patenting rejection of claims 1-20 be withdrawn.

B. Rejection of Claims 1-3, 6, 7, 12-15 and Pursuant to 35 U.S.C. § 103

Identification in the prior art of each individual part claimed in a patent is insufficient to defeat patentability of the whole claimed invention. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir.

2000); *In re Rouffett*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by applicant. *In re Kotzab*, 217 F.3d at 1370. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *Id.* The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. *Id.* In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. *Id.* The test for an implicitly showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *Id.* Whether the Board of Patent Appeals and Interferences relies upon an express or an implicit showing, it must provide particular findings related thereto. *Id.* Broad conclusory statements standing alone are not “evidence.” *Id.* (quotes in the original).

Applicant respectfully disagrees with the Examiner’s reasons for rejection of claims 1-3, 6, 7, 12-15, and 20 as allegedly being obvious over Fairchild. Fairchild does not disclose, teach or suggest a polymer absorbing a water insoluble alcohol such that the weight of the polymer is increased as a result of the absorption of the water insoluble alcohol by the polymer. Instead, as discussed at Col. 3, line 65 - Col. 4, line 7, Fairchild discloses mixing the “liquid, non-solvent” with

the “polymer mixture” which includes polymer as well as solvent. See Col. 3, lines 36-62. The “polymer” is then “precipitate[d] into polymer particles” contained in the non-solvent/solvent mixture before the solvent is separated out of the mixture. Col. 4, lines 3-34. Nowhere in Fairchild is any disclosure of the polymer absorbing the non-solvent such that the weight of the polymer is increased. For this reason alone, neither the originally filed claims or the amended claims are rendered obvious by Fairchild.

While Applicant submits that Fairchild does not render any of the original claims obvious, Applicant has amended the claims to further point out the distinction between using a non-solvent to precipitate polymer out of a solvent and contacting a polyalphaolefin with a water insoluble alcohol under certain conditions such that the alcohol is absorbed by the polymer. Specifically, Applicant amends the claims to recite that polyalphaolefin is cryoground. Support for the amendments is found at page 8, lines 9-10; 14-15.

As is evident by the disclosure of Fairchild, the polymerization process and recovery of polymer in Fairchild is performed by way of precipitation polymerization. As such, the “polymer particles” are formed due to the addition of a non-solvent to the polymer/solvent mixture. On the other hand, the amended claims, recite “cryogrinding” the polyalphaolefin into smaller polyalphaolefin particles. Therefore, the step of cryogrinding is consistent with the distinction between using a non-solvent to recover, through precipitation, “polymer particles” from a polymer/solvent mixture and contacting polyalphaolefin with a water insoluble alcohol under certain

conditions such that the polyalphaolefin absorbs the water insoluble alcohol to increase the weight of the polyalphaolefin.

Accordingly, Applicant respectfully submits that amended claims 1-3, 6, 7, 12-15, and 20 are patentable over Fairchild and respectfully requests that the rejection of amended claims 1-3, 6, 7, 12-15, and 20 under the provisions of 35 U.S.C. § 103(a) be withdrawn.

C. Claims 4, 5, 8-11, and 16-19

Claims 4, 5, 8-11, and 16-19 are dependent claims depending, ultimately, on either independent claim 1 or independent claim 12. Applicant submits that these claims, as originally filed, are patentable. Applicant further submits that claims 4, 5, 8-11, and 16-19 are patentable in light of the foregoing amendments.

Application Serial No. 10/826,580
Amendment dated August 17, 2005
In response to Office Action dated July 7, 2005

III. CONCLUSION

In view of the above amendments and remarks, Applicant respectfully requests that the amendments to the claims be entered, that the rejection of claims 1-3, 6, 7, 12-15, and 20 be withdrawn and that a notice allowance with respect to claims 1-20 be issued. In order to expedite the examination of this application, Applicant requests the Examiner to contact the undersigned at (713) 220-4168 to discuss any matters that can be resolved by telephone.

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Respectfully submitted,



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